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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE
3

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex Parte* JOHANN BONN, KLAUS LORENZ, JORG WEHRLE, and
8 MANFRED MATZ
9

10 Appeal 2009-009443
11 Application 10/519,405
12 Technology Center 1700
13

14 Oral Hearing Held: January 12, 2010
15 |
16 Before CATHERINE Q. TIMM, MICHAEL P. COLAIANNI, and
17 JEFFREY B. ROBERTSON, *Administrative Patent Judges.*
18 ON BEHALF OF THE APPELLANT:
19 HARRIS A. PITLICK, ESQUIRE
20 Oblon, Spivak, McClelland, Maier & Neustadt, LLP
21 1940 Duke Street
22 Alexandria, VA 22314
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1 The above-entitled matter came on for hearing Tuesday, January 12,
2 2010, commencing at 9:00 a.m., at the U.S. Patent and Trademark Office,
3 600 Dulany Street, Alexandria, Virginia, before Ronaldo Otero, a Notary
4 Public.

5 THE USHER: -- Mr. Pitlick.

6 JUDGE TIMM: Good morning, Mr. Pitlick.

7 MR. PITLICK: Morning.

8 JUDGE TIMM: As you know, we have Mike Colaianni; myself,
9 Catherine Timm; and Jeff Robertson here today. And if you would spell
10 your name for the court reporter, it would be much appreciated.

11 MR. PITLICK: I can give him my business card.

12 JUDGE TIMM: That'll work. And you can begin anytime you're
13 ready.

14 MR. PITLICK: Okay. We have one issue in this case, and that has to
15 do with the written description requirement, 35 U.S.C. 112, first paragraph,
16 whether we're in compliance with it.

17 The invention here is an oil and water emulsion, or I should say
18 dispersion, as a defoaming agent, or defoaming composition. We have a
19 hydrophobic component. We have an aqueous component. And we have an
20 additive. The invention here is the combination of two different types of
21 materials as the additive one is particular bisamide and one is a particular
22 ester.

23 Now, as disclosed originally, we had a number of possibilities for the
24 hydrophobic component. We claimed it with a Markush group of applicable
25 materials during the prosecution because of the prior art and for whatever
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1 other reasons. We put in an exclusion that the dispersion contains neither a
2 fatty alcohol having I think it's 12 to 26 carbon atoms or an alkoxylated fatty
3 alcohol.

4 And because the written description indicates that you can have other
5 materials as to hydrophobic component, as we've indicated in our Briefs,
6 that we think In re Johnson -- and I won't give you -- the citation is in the
7 Briefs -- is right on point here.

8 Now, the Examiner's reasoning is that because both bisamide and the
9 ester is necessarily a reaction product of at least for the amide -- it would be
10 an amine and the fatty alcohol and for the acid, it would be -- sorry -- for the
11 ester, it would be an alcohol and the acid -- that because when you react
12 these particular compounds to get the amide or to get the ester, you're not
13 going to have an equilibrium reaction, et cetera, et cetera, and you're going
14 to have some acid left over.

15 Our response to that is, first of all, you have to look at the Claims.
16 The Claim says bisamide and it says and ester. And by the way, we've
17 indicated in the Briefs, it's an at least partial ester where the alcohol
18 component, which, in this case is a glycerol, is either going to be in excess
19 or you're going to have 1:1, but the acid is never going to be in excess. But
20 anyway, as we pointed out, these materials, the bisamide and the ester -- I
21 think it's a glycerol ester, if I'm not mistaken -- are known materials.
22 Nothing particularly inventive in the materials themselves or how they're
23 made. As I said, the invention is in the combination.

24 So, again, we believe that In re Johnson is right on point, that the
25 inventors certainly had possession as of the filing date of dispersion that had
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1 neither the fatty alcohol or the alkoxylated fatty alcohol. I might also
2 indicate that it appears that in terms of the alkoxylated fatty alcohol, the
3 Examiner seems to have dropped that particular finding, or holding, because
4 it's not discussed in the Examiner's answer. But certainly, the Examiner is
5 adhering to the fatty alcohol having 12 to 26 carbon atoms, which he says by
6 excluding that we don't comply. But as I've indicated, we do. We had
7 possession of the dispersion without those two materials. And that is our
8 case in a nutshell.

9 JUDGE ROBERTSON: Mr. Pitlick, I think one of the questions the
10 Examiner has is that you indicated that the glycerol component would
11 always be present in excess or at the very least, 1:1?

12 MR. PITLICK: Yes.

13 JUDGE ROBERTSON: But the Examiner says that the limit that
14 you're claiming is at least 20 percent, which would include the 100 percent
15 that you've had in your spec --

16 MR. PITLICK: Well, that's right. That would be 1:1.

17 JUDGE ROBERTSON: Right. But the Examiner's position, I think,
18 is that there would have to be excess acid present to drive the equilibrium to
19 the 100 percent, and therefore you'd have -- in a reaction product, you'd have
20 presence of acid in the absence of any disclosed removal steps in your
21 specification.

22 MR. PITLICK: Well, like I said, if you look at our specification --
23 and as I've indicated, these materials are commercially available materials.
24 We're not making it. And we don't know what's -- you know, we don't know
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1 how they're made out in industry. We're claiming an ester, or we're citing an
2 ester; we're citing bisamide. You've go to take that at face value.

3 To me, it's like having a claim where you have an organic solvent
4 solution and you say it doesn't contain water. And the Examiner says, well,
5 since there is no vacuum out there, it's out in the atmosphere, it's going to
6 have a certain amount of moisture. Therefore, you can't exclude water. I
7 don't see how that's different from what we have. You have to look at the
8 claim language and the fact that he's suggesting that -- and again, he's
9 testifying here. We don't know whether he's right or not. We don't think it's
10 relevant. That's why we didn't respond to that specifically.

11 But you have to look at the claims. And the claim basically says an
12 ester and an amide, a particular amide. And I think that's sufficient. And
13 don't think you have to go any further than that.

14 JUDGE TIMM: Well, I think the question is whether your
15 specification indicates that you, or that the Appellant, is in possession of the
16 material. And if you're grabbing these things off the shelf, you have some
17 evidence that they actually do not have these carboxylic acids. And you do
18 have a very specific exclusion in your claim.

19 MR. PITLICK: Right. But I don't see how that matters. We're
20 claiming -- again, the claim says a bisamide and a glycerol ester. Focus on
21 the ester and the amide. An ester does not have any free acid. An amide
22 doesn't have any free acid -- I'm sorry -- and ester doesn't have any free
23 alcohol. You know, I'm sorry. I keep saying -- and I've misspoke. I said
24 fatty alcohols 12 to 26 and I meant to say fatty acids, so please make that
25 correction.

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1 All right. Let's go back. An amide is a product of an acid and an
2 amine and an ester is a product of an acid and an alcohol. We're claiming an
3 ester and we're claiming an amide. An ester does not contain any acid. An
4 amide doesn't contain any acid. And to me, that is the only thing you have
5 to look at. We certainly have basis for excluding the acid and the
6 alkoxylated fatty alcohol because, as I say, we have disclosed a number of
7 embodiments for the hydrophobic compound. It doesn't have to have the
8 acid, and it doesn't have to have the alkoxylated fatty alcohol.

9 And, again, *In re Johnson* is right on point. If you exclude them,
10 you're not violating the description requirement. And I must say that the
11 Examiner's rationale here is a red herring, and it's totally irrelevant.

12 JUDGE TIMM: I think we understand your position. Do you have
13 any questions?

14 JUDGE COLAIANNI: No questions.

15 JUDGE TIMM: Any questions?

16 JUDGE ROBERTSON: No.

17 JUDGE TIMM: Okay.

18 MR. PITLICK: Thank you.

19 JUDGE TIMM: We're off the record.

20 Whereupon, the proceedings, at 9:10 a.m., were concluded.

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